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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,327	12/05/2003	Penny L. Gerstner	1538US1.014033.018	1326
69603 7590 07/21/2010 MOORE & VAN ALLEN, PLLC FOR BOFA 430 DAVIS DRIVE, SUITE 500 POST OFFICE BOX 13706 RESEARCH TRIANGLE PARK, NC 27709			EXAMINER EBERSMAN, BRUCE I	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 07/21/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,327	Applicant(s) GERSTNER ET AL.	
	Examiner BRUCE I. EBERSMAN	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments, see pre-appeals conference request, filed 3/24/10, with respect to the rejection(s) of claim(s) 1-35 under 35 USC 102(e) and 35 USC 103 (a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

Applicant filed a pre-appeal conference request on 3/24/10 after a final rejection on 12/24/09. Claims 1-35 pending. After careful consideration of the applicant's arguments and amendments, the examiner finds them moot in view of new grounds of rejection. This action is a non-final office action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 11,21,26 and recite "forwarding, from the financial institution, an account holder confirmation of the at least one participant confirmation of the at least one specific request to the account holder." (Claims 11, 21,26 are similar though not

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identical. The claim language is unclear because the examiner cannot determine how or when any notification was received by the the account holder so how is it possible for an account holder confirmation of at least one participant confirmation to occur? Is the account holder is notified so that the account holder can confirm that the transactions have been transferred to the new institution? Or is the account holder being asked to confirm the transactions prior to making a change? Or is the confirmation a summary of the activities which have been undertaken?

The examiner in summary cannot determine why the account holder receives a confirmation at the final step but, no initial notification was provided to inform the holder that an activity was occurring or confirming the original request.

For the purposes of examination, the examiner presumes that the applicant is being notified that the transaction request is complete, that the recurring transaction is now transferred to the new financial institution.

Claims 2-10,12-20 and 22-25, 27-35 are rejected because they depend on claims 1, 11, 21 and 26 respectively

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fewer Glitches for Switchers It is easier than ever to change accounts, says Stephen Ellis, Daily telegraph, London UK, Nov 17, 2001 p. 11, 2 pages in view of US Patent 7376587 to Neofyides..

As per claim 1, Fewer Glitches discloses;

A computer-implemented method of processing account-holder requests to authorize recurring a plurality of third-party transactions for an account at a financial institution on behalf of an account holder, the method comprising:
(see glitches para. 9,10, user signs the authorization, then bank contacts the old bank so that any regular transactions, bill payments, orders, regular transfers into your account can be transferred to the new bank)
receiving, at the financial institution, the account-holder requests to authorize the plurality of third-party transactions by a third-party entity other than the financial institution or the account-holder; (sign a form at your bank and then leave them to sort the transfer process out para. 8-10)
matching, using a computer, at least one specific request from among the account-holder requests to at least one specific third-party participant; (the bank takes the participant requests, then gets the contact list from the old bank, the old bank data is

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used by the new bank to notify the participants that the user is changing bank accounts para. 8-1)

forwarding the at least one specific request to the at least one specific third-party participant on behalf of the account holder; (at least one request is forwarded to a 3rd party on behalf of the account holder, that is how the 3rd party direct debiter knows or is informed of the changes para. 10, the new bank contacts all relevant organizations) receiving, at the financial institution, at least one participant confirmation from the at least one specific third-party participant, wherein the at least one participant confirmation comprises a confirmation that the at least one specific third-party participant's accounting system has been updated based on the at least one specific request; (it is up the new bank to contact all relevant organizations and to given them the details of your new bank account and set up all the payments and transfers. p. para 8-10)

and forwarding, from the financial institution, an account-holder confirmation of the at least one participant confirmation of the at least one specific request to the account holder. (the bank can also provide a send you a list to look over to make sure that all of the arrangements are up to date, the bank does it all for the customer, this last phase is unclear under 35 USC 112 2nd, see above , para 8-10)

Fewer Glitches discloses automated systems but, not explicitly computer implemented hardware and software.

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Neofytides teaches automated systems but, not explicitly computer implemented hardware and software. (col. 1 lines 57- col. 2 line 2 and col. 6 line 37 through col. 7 line 23)

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to combine the automated switch system of Fewer Glitches with the computer automation of Neofytides for the motivation of conveniently handling automated payment transactions. (col. 1, lines 15-30)

Claims 11, 21, and 26 are rejected for similar reasons as claim 1.

As per claim 2, Fewer Glitches discloses a preexisting list of prospective third party participants. (ie. A list of the account holder participants is disclosed.

Fewer Glitches does not explicitly disclose a list which pre-existed the transaction.

, Neofytides et al. teaches establishing a pre-existing list of prospective third-party participants, wherein the at least one specific third-party

participant is selected from the pre-existing list (See col. 9, line 52, through col. 10, line 49, which discusses an address book that functions as a source of prospective payees).

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to combine the automated switch system of Fewer Glitches with the pre-existing list of Neofytides for the motivation of conveniently handling automated payment transactions. (col. 1, lines 15-30)

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As per claim 3, Fewer Glitches does not explicitly disclose 3rd party participant preferences. Neofytides et al. teaches wherein at least one of the forwarding of the at least one specific request to the at least one specific, third-party participant and the receiving, at the financial institution, the at least one participant confirmation from the at least one specific third-party participant is accomplished in accordance with participant communication preferences stored in a participant profile for the at least one specific third-party participant, the participant profile being stored in a data repository comprising participant profiles associated with the prospective third-party participants (See col. 10, line 49, through col. 11, line 19, which discusses registering an individual or payee's profile, storing the profile, and confirming the profile according to a preferred method). It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to combine the automated switch system of Fewer Glitches with the preferences of Neofytides for the motivation of conveniently handling automated payment transactions. (col. 1, lines 15-30)

As per claim 4, Fewer Glitches does not explicitly disclose account holder communication preferences. Neofytides et al. teaches wherein the forwarding, from the financial institution, of the account-holder confirmation of the at least one participant confirmation of the at least one specific request to the account holder is accomplished in accordance with account-holder communication preferences stored in an account-holder profile (See col. 8, lines 26-54, which discusses a user or payor profile and how a user or payor may confirm a money receipt method).

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It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to combine the automated switch system of Fewer Glitches with the account holder communication preferences of Neofytides for the motivation of conveniently handling automated payment transactions. (col. 1, lines 15-30)

Claim 5 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

As per claim 6, Fewer Glitches discloses regular direct debit , standing orders, bill payments and regular transfers into your account. (direct deposits are a form of regular transfers into your account.

Claims 7-10 recite equivalent limitations to claim 6 and are therefore rejected using the same art and rationale set forth above.

Claims 12-14 recite equivalent limitations to claims 2-4, respectively, and are therefore rejected using the same art and rationale set forth above.

Claim 15 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

Claim 16-20 recites equivalent limitations to claim 6 and are therefore rejected using the

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same art and rationale set forth above.

Claims 22-24 recite equivalent limitations to claims 2-4, respectively, and are therefore rejected using the same art and rationale set forth above.

Claim 25 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

Claim 27 recites equivalent limitations to claim 2 and is therefore rejected using the same art and rationale set forth above.

Claim 28 recites equivalent limitations to claim 6 and is therefore rejected using the same art and rationale set forth above.

Claim 29 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

As per claim 30, Fewer Glitches does not explicitly disclose; account-holder communications preferences.

Neofytides et al. teaches wherein the account-holder communication preferences comprises at least one of electronic and paper communication preferences (See claim

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1, which discusses communicating by an email address).

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to combine the automated switch system of Fewer Glitches with the pre-communication preferences of Neofytides for the motivation of conveniently handling automated payment transactions. (col. 1, lines 15-30)

Claim 31 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

Claim 32 recites equivalent limitations to claim 30 and is therefore rejected using the same art and rationale set forth above.

As per claim 33, Fewer Glitches does not explicitly disclose the internet for account holder requests. Neofytides et al. teaches wherein the user interface is operable to receive the account-holder requests from the account-holder over the internet (See figure 1, which illustrates receiving user requests over the internet).

It would therefore have been obvious to one of ordinary skill in the art at the time of the invention to combine the automated switch system of Fewer Glitches with the communication preferences of Neofytides for the motivation of conveniently handling automated payment transactions. (col. 1, lines 15-30)

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Claims 34 & 35 recite equivalent limitations to claim 33 and are therefore rejected using the same art and rationale set forth above.

Response to Arguments

Applicant's arguments, see pre-appeals conference request, filed 3/24/10, with respect to the rejection(s) of claim(s) 1-35 under 35 USC 102(e) and 35 USC 103 (a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

35 USC 101 - persuasive, and thereby withdrawn in view of amendment to claim 1.

35 USC 102/103(a)- new grounds of rejection are offered in view of applicant concerns.

Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

3. US Patent Publication 2003/0225688 to Dobbins – a financial account transfer apparatus and method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRUCE I. EBERSMAN whose telephone number is (571)270-3442. The examiner can normally be reached on 630am-5pm, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art Unit 3691

Bruce I Ebersman
Examiner
Art Unit 3691
